REMARKS

Claims 18-20, 23-24, 26, 28, 30, 34-36, 111, and 155 have been amended. Claims 1-17, 21, 31, 33, 50, 52, 54-59, 62-67, 73-74, 81, 87, 89-95, 97-102, 108-109, 116, 119-154, and 156-163 were previously canceled. Currently claims 18-20, 22-30, 32, 34-49, 51, 53, 60-61, 68-72, 75-80, 82-86, 88, 96, 103-107, 110-115, 117-118 , and 155 are pending in the application. No new matter has been added through the claims amendments and, as such, applicants respectfully request entry of the present amendment.

Claim objections

The Examiner objected to claim 24 for including "or" before "SEQ ID NO:20." The claims amendments have rendered this ground of objection moot. Accordingly, applicants request withdrawal of this ground of objection.

35 U.S.C. §112, first paragraph (new matter)

The Examiner has rejected the claims for the addition of the word "human" in the claims as new matter. Applicants are quite perplexed how this can be new matter given the explicit description of human antibodies, and human scFv fragments in the specification. For example, paragraph [193] the specification states: "One example of an antibody of the present invention that binds to epitopes of Formulae I-III is the fully human monoclonal antibody Y1." In paragraph [197] it states that: "Full Y17-IgG antibodies were also produced," and Y17 scFv is noted as a human scFv (See paragraph [238] "Y17, a second scFv human antibody fragment of the invention.").

Further, not only does the specification explicitly describe human antibodies, one skilled in the art would understand that the whole point in generating antibodies from human phage display is to generate human antibodies. Thus, one skilled in the art would clearly understand that the specification described human antibodies in that two human antibodies Y1 and Y17 are explicitly disclosed and in addition, the method of identifying and making the antibodies (through the use of human phage display) describes human antibodies. Accordingly, applicants request reconsideration and withdrawal of this ground of rejection.

35 U.S.C. §112, first paragraph (written description)

The Examiner has rejected claims 26-29 for inadequate written description. The claims have been amended to depend from claims 18-20. Applicants submit that the present claim amendments render this ground of rejection moot and request withdrawal of this ground of rejection.

35 U.S.C. § 102(b)

The Examiner has rejected claims 30, 32, 24-37, 39, 45, 47, 48 and 155 under 35 U.S.C. §102(b) for inadequate written description. The claims have been amended to depend from claims 18-20. Applicants submit that the present claim amendments render this ground of rejection moot and request withdrawal of this ground of rejection.

Provisional double patenting rejection

The Examiner has provisionally rejected the claims over co-pending application 10/029,988 and 10/189,258. As these applications have not yet issued as patents, applicants request that the Examiner hold this rejection in abeyance until they issue as patents. If a terminal disclaimer becomes necessary (if the applications were to issue before the present claims issue) applicants will file a terminal disclaimer.

The Examiner had rejected the claims over U.S. Patent 7,132,510. Upon receiving a notice of allowability for the present claims, applicants will submit a Terminal Disclaimer over U.S. patent 7,132,510.

Conclusion

If, in the opinion of the Examiner, a telephone conference would expedite prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

The Office is authorized to charge any fees that may be necessary for consideration of this paper to Kenyon & Kenyon Deposit Account No. 11-0600.

Respectfully submitted,

KENYON & KENYON

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